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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,705	03/30/2004	J. Richard Gyory	ALZA-0377/ALZ5016USANP	7214
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WOODCOCK WASHBURN LLP CIRA CENTRE, 12TH FLOOR 2929 ARCH STREET PHILADELPHIA, PA 19104-2891			EXAMINER GILBERT, ANDREW M	
			ART UNIT 3767	PAPER NUMBER
			NOTIFICATION DATE 11/05/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@woodcock.com

# Office Action Summary

Application No.

10/814,705

Applicant(s)

GYORY, J. RICHARD

Examiner

Andrew M. Gilbert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 17-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/24/2007 has been entered.

### ***Acknowledgments***

2. This office action is in response to the reply filed on 8/24/2007.
3. In the reply, the applicant cancelled claims 1-16 and added new claims 17-21.
4. Additionally, the Applicant cancelled newly submitted Figure 5, thus obviating the previous objection to the specification.
5. Thus, claims 17-21 are pending for examination.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 17-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Flower (5857994). Flower discloses an electrotransport device (Fig 1) comprising: a non-conductive reservoir housing (4) comprising a substantially flexible electrically conductive element (8, 26) integrally molded within the non-conductive housing (Fig 1-2, wherein the housing 4 is shown by the dotted lines in Fig 2 and the conductive element is shown outside the housing 26 and entering the housing 4 to contact 8), wherein a first portion (portion of 26 that contacts 8 inside the housing 4 – whose boundaries are shown by dotted lines in Fig 2) of the conductive element is within the reservoir housing and a second portion (portion of 26 outside of the dotted lines of 4 and that goes and contacts 27 – Fig 1, 2) of the element is disposed on the outside of the reservoir housing and extends therefrom, and wherein a substantially liquid and moisture-impermeable bond is created between the material forming the reservoir housing and the conductive element (Fig 1-2, wherein the bond is inherently liquid and moisture-impermeable as the conductive element would inherently lose functionality of conduction upon liquid or moisture leakage between the housing 4 and the conductive element 26. The bond of Flowers is substantially impermeable to liquid and moisture as the traversing conductive element is sealed by the housing 4); wherein the reservoir housing is a single integral component (4, Fig 1, 2); wherein the electrotransport device is manufactured without the fabrication of openings or other passages through the reservoir housing (4, Fig 1, 2); wherein the conductive element comprises a substantially planar member (26, Fig 1); wherein the conductive element includes a

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base member having a conductive coating disposed thereon (26; Fig 1, col 4, lns 28-31).

8. Claims 17-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Kuribayashi et al (6915159). Kuribayashi et al discloses an electrotransport device (Fig 1-12) comprising: a non-conductive reservoir housing comprising a substantially flexible electrically conductive element (2, 14, 15, Fig 1a-c, 5a-b, 6a-c) integrally molded within the non-conductive housing (1), wherein a first portion (2, 14, or 15, that contacts conductive drug layer 9, 12, or 13 – Fig 1a-c, 5a-b, 6a-c) of the conductive element is within the reservoir housing and a second portion (2, 14, 15 that is exterior and forms exterior connector that can be connected to 18 – see Fig 5b, 6b-c, 8) of the element is disposed on the outside of the reservoir housing and extends therefrom, and wherein a substantially liquid and moisture-impermeable bond is created between the material forming the reservoir housing and the conductive element (Fig 1a-c, 5a-b, 6a-c, 8; wherein the bond is inherently liquid and moisture-impermeable as the conductive element would inherently lose functionality of conduction upon liquid or moisture leakage between the housing 1 and the conductive element 2, 14 or 15. The bond is substantially impermeable to liquid and moisture as the traversing conductive element is sealed by the housing 1 and has external connectors 14 and 15 that connect to 18. Because the conductive elements are sealed in the housing no liquid or moisture can get between the conductive elements and the housing); wherein the reservoir housing is a single integral component (1; Figs 1, 5a-d, 6a-c, 8); wherein the electrotransport

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device is manufactured without the fabrication of openings or other passages through the reservoir housing (Figs 1, 5a-d, 6a-c, 8); wherein the conductive element comprises a substantially planar member (2, 14, 15; Figs 1, 5a-d, 6a-c, 8); wherein the conductive element includes a base member having a conductive coating disposed thereon (col 7, lns 1-5, 39-47).

### ***Response to Arguments***

9. Applicant's arguments filed 8/24/07 have been fully considered but they are not persuasive.

10. The Applicant argues that Flower and Kuribayashi et al do not teach or disclose a substantial liquid and moisture-impermeable bond created between the material forming the reservoir housing and the conductive element.

11. The Examiner respectfully disagrees. See above discussion of claim elements in 35 USC 102 rejections.

12. The Examiner additionally notes that the claim language of claims 17-21 has been significantly broadened. Because the Applicant has herein removed limitations directed towards drug reservoirs, electrodes, and power sources – the metes and bounds of the Applicant's inventions have been significantly broadened. The Examiner can reject the current claim limitations with a large variety of prior art including for instance a coaxial cable connector (that would fall under the scope of a current electrotransport device) or a plastic toy having electronic circuitry and wiring. The

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Examiner strongly recommends structurally narrowing the Applicant's claimed invention to properly detail the point of novelty of the Applicant's invention over the prior art.

### ***Conclusion***

13. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew M. Gilbert whose telephone number is (571)

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272-7216. The examiner can normally be reached on 8:30 am to 5:00 pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571)272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Andrew Gilbert

KEVIN C. SIRMONS  
SUPERVISORY PATENT EXAMINER

